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EXAMINER

WINTER, JOHN M

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 11/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/995,151

Applicant(s)

ROHALL ET AL.

Examiner

John M Winter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 27 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 10-16 and 18 is/are rejected.
- 7) ☒ Claim(s) 8, 9, 17, 19 and 20 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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## DETAILED ACTION

Claims 1- 20 have been examined

### *Claim Rejections - 35 USC §101*

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 1 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In claim 1 the applicant claims creating a shadow document from an original document; identifying one of a parent and child document of the original document and storing a reference thereto in the shadow document and storing the shadow document in memory. (Examiner notes that the term "memory" does not place the claimed invention within the technological arts, since a memory might be construed as journal or log).

Claims 2-9 are dependant upon Claim 1 and are rejected for at least the same reasons.

Claim 11 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter, "a computer data signal embodied in a carrier wave " is intangible.

All that is necessary to make a sequence of operational steps in a statutory process within 35 U.S.C. 101 is that it be in the technological arts so as to be in concordance with the Constitutional purpose to promote the progress of "useful arts" *In re Musgrave*, 431 F.2d 882 167 USPQ 280 (CCPA 1970)

A claim is limited to a practical application when the method, as claimed, produces a concrete, tangible and useful result: i.e. the method recites a step or act of producing something that is concrete, tangible and useful. *See AT&T v. Excel Communications Inc.*, 172 F3d at 1358, 50 USPQ2d at 1452.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 – 7,10-16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gay, (US Patent 6,792,145) in view of Rackman (US Patent No 5,903,646).

As per claim 1,

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Gay ('145) discloses in a computer system operatively coupled to a network and capable of executing a communication process for sending and receiving electronic mail documents, a method comprising:

storing the shadow document in memory.(Figure 2)

Gay ('145) does not explicitly disclose creating a shadow document from an original document; identifying one of a parent and child document of the original document and storing a reference thereto in the shadow document. Rackman ('646) discloses creating a shadow document from an original document;(Column 8, lines 15-17; figure 4A) identifying one of a parent and child document of the original document and storing a reference thereto in the shadow document,(Column 8, lines 47-52). It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Gay ('145) method with the Rackman ('646) in order to create a redundant data archive so that the document could be retrieved in the event of primary system failing.

As per claim 2,

Gay ('145) discloses the method of claim 1 wherein "A" further comprises:  
parsing the original document for selected of the logistical data.(Figure 2)

As per claim 3,

Gay ('145) discloses the method of claim 2

Official Notice is taken that "the logistical data comprises any of sender, receiver, original size, subject, date, carbon copies of the original document" is common and well known in prior art in reference to document analysis. It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize logistical data comprising information about the sender, receiver, subject etc.. in order to create a profile of the documents usage.

As per claim 4,

Gay ('145) discloses the method of claim 1 wherein "A" further comprises:  
filtering the original document for selected content.(Figure 2)

As per claim 5,

Gay ('145) discloses the method of claim 2

Gay ('145) does not explicitly disclose wherein the shadow document further comprises selected data from the content of the original document. Rackman ('646) discloses wherein the shadow document further comprises selected data from the content of the original document. (Figure 4A). It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Gay ('145) method with the Rackman ('646) in order to create a redundant data archive using the original content so that the document could be retrieved in the event of primary system failing.

As per claim 6,

Gay ('145) discloses the method of claim 1

Official Notice is taken that "the shadow document is created upon transmission of an original document to the communication process" is common and well known in prior art in reference to

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document analysis. It would have been obvious to one having ordinary skill in the art at the time the invention was made to create a copy of a document upon transmission in order to create a redundant data archive using the original content so that the document could be retrieved in the event of primary system failing. The Examiner notes that this feature is common so mail systems such as Microsoft Outlook.

As per claim 7,

Gay ('145) discloses the method of claim 1

Official Notice is taken that "the shadow document is created upon sending of an original document to the communication process" is common and well known in prior art in reference to document analysis. It would have been obvious to one having ordinary skill in the art at the time the invention was made to create a copy of a document upon transmission in order to create a redundant data archive using the original content so that the document could be retrieved in the event of primary system failing. The Examiner notes that this feature is common so mail systems such as Microsoft Outlook.

As per claim 10,

Gay ('145) discloses a computer program product for use with a computer system operatively coupled to a network and capable of executing a communication process for sending and receiving electronic mail documents, the computer program product comprising a computer useable medium having embodied therein program code comprising:

program code for storing the shadow document in memory.(Figure 2)

Gay ('145) does not explicitly disclose program code for creating a shadow document from an original document; program code for identifying one of a parent and child document of the original document. Rackman ('646) discloses program code for creating a shadow document from an original document;(Column 8, lines 15-17; figure 4A) program code for identifying one of a parent and child document of the original document (Column 8, lines 47-52). It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Gay ('145) method with the Rackman ('646) in order to create a redundant data archive so that the document could be retrieved in the event of primary system failing.

As per claim 11,

Gay ('145) discloses a computer data signal embodied in a carrier wave for use with a computer system operatively coupled to a network and capable of executing a communication process for sending and receiving electronic mail documents, the computer data signal comprising:

program code for storing the shadow document in memory.(Figure 2)

Gay ('145) does not explicitly disclose program code for creating a shadow document from an original document; program code for identifying one of a parent and child document of the original document. Rackman ('646) discloses program code for creating a shadow document from an original document;(Column 8, lines 15-17; figure 4A) program code for identifying one of a parent and child document of the original document (Column 8, lines 47-52). It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the

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Gay ('145) method with the Rackman ('646) in order to create a redundant data archive so that the document could be retrieved in the event of primary system failing.

As per claim 12,

Gay ('145) discloses an apparatus for use with a computer system operatively coupled to a network and capable of executing a communication process for sending and receiving electronic mail documents, the apparatus comprising:

program logic for storing the shadow document in memory. (Figure 2)

Gay ('145) does not explicitly disclose program logic for creating a shadow document from an original document, program logic for identifying one of a parent and child document of the original document. Rackman ('646) discloses program logic for creating a shadow document from an original document, (Column 8, lines 15-17; figure 4A) program logic for identifying one of a parent and child document of the original document. (Column 8, lines 47-52). It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Gay ('145) method with the Rackman ('646) in order to create a redundant data archive so that the document could be retrieved in the event of primary system failing.

As per claim 13,

Gay ('145) discloses the method of claim 1 further comprising:  
presenting graphical representations of a plurality of documents in a manner which indicates relationships among the documents. (Figure 5)

As per claim 14,

Gay ('145) discloses the method of claim 13  
wherein at least one of the plurality of presented documents is an original document. (Figure 5)

As per claim 15,

Gay ('145) discloses the method of claim 13  
wherein at least one of the plurality of presented documents is a shadow document. (Figure 5)

As per claim 16,

Gay ('145) discloses the method of claim 1 further comprising:  
resolving the reference in a shadow document to one of the parent and child document, and maintaining in memory data identifying a plurality of shadow documents and any parent and child documents thereof. (Figure 2)

As per claim 18,

Gay ('145) discloses in a computer system operatively coupled to a network and capable of executing a communication process for sending and receiving electronic mail documents, a method comprising:

storing the shadow document in memory. (Figure 2)

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Gay ('145) does not explicitly disclose creating a shadow document from an original document upon sending of the original document by the communication process, identifying one of a parent and child document of the sent original document and storing a reference thereto in the shadow document. Rackman ('646) discloses creating a shadow document from an original document upon sending of the original document by the communication process, (Column 8, lines 15-17; figure 4A) identifying one of a parent and child document of the sent original document and storing a reference thereto in the shadow document; (Column 8, lines 47-52). It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Gay ('145) method with the Rackman ('646) in order to create a redundant data archive so that the document could be retrieved in the event of primary system failing.

Gay ('145) does not explicitly disclose wherein identifying one of a parent and child document of the received original document and storing a reference thereto in the shadow document. Rackman ('646) discloses wherein identifying one of a parent and child document of the received original document and storing a reference thereto in the shadow document. (Figure 4A). It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Gay ('145) method with the Rackman ('646) in order to create a redundant data archive using the original content so that the document could be retrieved in the event of primary system failing.

Official Notice is taken that "creating a shadow document from an original document received from another communication process" is common and well known in prior art in reference to document analysis. It would have been obvious to one having ordinary skill in the art at the time the invention was made to create a copy of a document upon transmission in order to create a redundant data archive using the original content so that the document could be retrieved in the event of primary system failing. The Examiner notes that this feature is common so mail systems such as Microsoft Outlook.

### *Allowable Subject Matter*

Claims 8, 9, 17, 19 and 20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### *Conclusion*

Examiners note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

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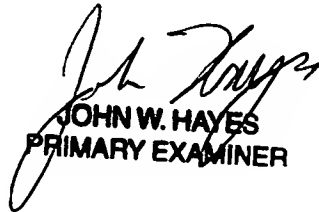
Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M Winter whose telephone number is (703) 305-3971. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P Trammell can be reached on (703)305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

JMW

October 27, 2004

  
JOHN W. HAYES  
PRIMARY EXAMINER